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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,584	11/14/2000	Daniel Arturo Delfin Farias	SJO919990173	9711

46917 7590 04/21/2005

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EXAMINER

O'CONNOR, GERALD J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/712,584

Applicant(s)

Farias et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on October 4, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on November 14, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on October 4, 2004 in reply to the previous Office action, mailed June 28, 2004.
2. The amendment of claims 13 and 18 by applicant in the reply filed October 4, 2004 is hereby acknowledged.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-38, 58-67, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification (see, in particular, pages 1, 2, and 6-8), in view of Johnson et al. (US 5,712,989).

The admitted prior art includes a method of ordering products that comprises performing all of the recited sequence of operations/steps/functions, but only includes performing certain of the steps using a computer, leaving other of the steps to be performed manually, and does not appear to include the step of "performing computer-related operations to process information

from the supplier indicating a commitment quantity of a number of the products the supplier intends to ship to the RSC to meet the requested quantity.”

However, Johnson et al. disclose a similar method of ordering products, and the method of Johnson et al. indeed includes the step of performing computer-related operations to process information from the supplier indicating a commitment 372 quantity of a number of the products the supplier intends to ship to the RSC to meet the requested quantity.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the known prior art system so as to include the step of performing computer-related operations to process information from the supplier indicating a commitment quantity of a number of the products the supplier intends to ship to the RSC to meet the requested quantity, in accordance with the teachings of Johnson et al., in order to improve the integrity/reliability of the method by making use of computer-based records of orders, inventory, and transactions.

5. Claims 39-57 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification (see, in particular, pages 1, 2, and 6-8), in view of Johnson et al. (US 5,712,989), and further in view of Graves et al. (US H1743).

Graves et al. disclose a computer method for ordering products by means of a network of computers, which computer method clearly anticipates the instant claims, except that the method of Graves et al. involves only two entities (a manufacturer ordering directly from a supplier)

rather than three entities (a manufacturer, receiving supplies from a distributor/middleman, the distributor/middleman first receiving the supplies from a supplier).

However, the third party distributors/middlemen are well known to those of ordinary skill in the art, hence, obvious elements to include in such a method. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the computer method of Graves et al. so as to duplicate its functionality, as required, to form a three link supply chain instead of a two link supply chain, in order to accommodate an intermediate third party, such as a distributor/middleman, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

#### ***Response to Arguments***

6. Applicant's arguments filed Oct. 4, 2004 have been fully considered but are not persuasive.

7. Regarding the arguments with respect to claims 1-38, 58-67, and 69 generally, the examiner notes at the outset that, unlike claims 39-57 and 68, none of these claims require any computer performing any of the recited functionality/steps. That is, the computer does not necessarily have to perform the recited steps itself, since the claims read merely on humans performing the steps, using a computer for some steps (e.g., a human composing and sending a message via e-mail or fax, as opposed to the computer actually composing the e-mail itself).

8. Regarding the argument that the admitted prior art does not include steps that the examiner specifically stated in the rejection that it did not include, the argument has been disregarded as spurious, since it fails to point out or specify any particular aspect of the rejection that applicant views as improper, and is utterly unresponsive to the actual rejection.

9. Regarding applicant's arguments against the references individually (i.e., that the admitted prior art does not show features taught by Johnson et al., and that Johnson et al. do not show features comprised by the admitted prior art), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. Regarding the argument that Johnson et al. fail to disclose that "the acquiring entity processes a request from the supplier for information" (i.e., the supplier asks when and how much of what, and the acquiring entity responds to the supplier with the answer), and "then receives information from the supplier indicating a commitment quantity that the supplier intends to ship to meet the acquiring entity's request" (i.e., the supplier responds with a planned/promised shipment commitment), wherein the supplier uses the answer to the question of when and how much of what to determine what shipment plan/promise/commitment to make (i.e., filling the request/order), the just-in-time system of Johnson et al. obviously indeed includes all such functionality, either explicitly or inherently. Again, the teaching relied upon in

Johnson et al. is for performing such functionality via “computer-related” operations as claimed, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

11. Regarding the argument that the references fail to show certain features of applicant’s invention as recited in claim 18, it is noted that the features upon which applicant relies (i.e., presumably that “pulled by the acquiring entity” can *only* mean “shipped to another company,” as opposed to “merely taken off the shelf by the person who needs it”) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12. Regarding the argument that, if method claims 1, 13, and 18 are patentable, and apparatus claims 20, 32, and 37 recite the functionality of method claims 1, 13, and 18, then the apparatus claims must be patentable as well, the argument has been deemed specious, since a recitation of the intended use of claimed apparatus must result in a *structural* difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable* of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative

difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Moreover, apparatus claims must be *structurally* distinguishable from the prior art. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). See MPEP § 2114.

13. Regarding the arguments concerning the *In re Lee* case, *vis-à-vis* the examiner’s statement of what is well known, applicant is confused, because the *In re Lee* case is completely irrelevant to the issue at hand. The *In re Lee* case concerns the issue of motivation to combine whereas the issue at hand is the question of what is or isn’t prior art. In *In re Lee* the Court found that the stated motivation to combine two prior art references was improper/insufficient for being too conclusory, since the stated motivation was that it was merely common sense or well known. Here, the statement of what is well known concerns the scope and content of the prior art, not the motivation to combine that known prior art with any other prior art. Such a statement can indeed properly support such a rejection, since, “the rationale supporting an obviousness rejection may be based on common knowledge in the art or ‘well-known’ prior art.” See MPEP § 2144.03. Furthermore, as applicant has failed to seasonably provide any traverse to the examiner’s stated positions as to what is well known prior art, and, as any traverse at this point would no longer be considered seasonable, the objects of the well known statements are therefore now deemed and considered henceforth to be admitted prior art.



***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(571) 272-6788**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC



April 18, 2005

 4/18/05

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